

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed on October 27, 2003. Claims 1, 2, 4, 6-11, 14-16, 18-21 and 25-38 are pending in the Application. No claims have been amended. Applicants respectfully request reconsideration and favorable action in this case.

**Section 102 and 103 Rejections**

The Office Action rejects Claims 1, 4, 6, 7, 9 and 11 under 35 U.S.C. § 102(b) as being anticipated by *Oelsch* (U.S. Patent No. 4,743,722) and Claims 2, 8, 15, 16, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over *Oelsch* in view of *Randall, et al.* (U.S. Patent No. 6,100,477). Applicants respectfully traverse these rejections for reasons provided below.

In Applicants' response to the above rejections filed September 30, 2003, Applicants argued, in part, that *Oelsch* does not include sections that resiliently vary in size in a direction lengthwise of said membrane. The Office Action did not challenge this. Rather, referring to Claim 1, the Office Action argued that (i) the pertinent claim limitations did not require particular portions of *Oelsch* to actually resiliently vary in size, but only that they be *capable* of doing so, and (ii) that the particular portions of *Oelsch* were *capable* of resiliently varying in size. Office Action at paragraph 2. This argument fails because (i) the particular portions of *Oelsch* alleged to be capable of resiliently varying in size are not disclosed by *Oelsch* to be capable of "resiliently varying in size in a direction lengthwise of said membrane," which is the pertinent claim language, and (ii) other limitations of the claims are not shown by *Oelsch*.<sup>1</sup>

Method claim 15 recites "configuring said membrane to include outer portions that each extend a selected distance outwardly from a respective one of said first and second sections to a respective one of said first and second" and "responding to an applied voltage between said conductive part and said conductive portion by resiliently flexing said membrane . . . said outer portions each extending in a direction which is approximately normal to a direction of movement of said conductive portion." *Oelsch* does not disclose

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<sup>1</sup> Certain claims were rejected as being unpatentable over *Oelsch* in view of *Randall*. However, *Randall* was merely used to teach a dielectric layer and operation by an applied voltage. Therefore, the asserted teachings of *Randall* are not pertinent to the argued limitations.

such outer portions that move in a direction that is approximately normal to the direction of movement of the conductive portion, nor does the Office Action assert it does. As described in Applicants previous response, portions 7 and 8 of *Oelsch* remain rigid and force the center of the membrane to flex in response to increases in length of membrane 3,<sup>2</sup> and thus no portions that extend outwardly from portions 7 and 8 could have a change in position characterized as "extending in a direction which is approximately normal in a direction of movement of said conductive portion." Indeed, even the Office Action implies no such extension occurs by any outer portions of the membrane by noting that the "sections" of *Oelsch* are merely "capable" of yieldably varying in size and that "to be capable of something does not require or imply that it actually occur." For at least this reason, Claim 15 is allowable. Reconsideration and favorable action are requested.

Claim 16 additionally recites "effecting expansion of each of said first and second sections as said membrane is moved from said first position to said second position." *Oelsch* does not disclose this limitation nor does the Office Action assert it does. Rather, portions 7 and 8 "do not practically change their shape in this process and have no substantial influence on the switching behavior." Column 3, lines 41-43. Further, the Office Action concedes that the claimed sections of *Oelsch* merely need to be capable of yieldably varying in size, and that to be capable of something does not require or imply that it actually occur. As the claim language explicitly recites "effecting expansion" of the sections, and *Oelsch* does not effect expansion of the section, the rejection is clearly improper. For at least this additional reason, the rejection is improper. Reconsideration and favorable action are requested.

Claim 19 additionally recites "including the step of causing each of said first and second portions of each said membrane section to tilt with respect to said third portion thereof in response to the application to said membrane of one of a lengthwise expansion force and a lengthwise contraction force." *Oelsch* does not show this limitation, nor does the Office Action assert it does. As described above, portions 7 and 8 "do not practically change their shape in this process and have no substantial influence on the switching behavior" and the Office Action itself appears to concede no such change in shape takes place. For at least

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<sup>2</sup> If the *Oelsch* membrane 3 absorbs moisture, it may increase slightly in length. As clearly explained at lines 3-7 in column 3, this results in the center of the membrane being forced to arch further upwardly, as indicated by broken lines in FIGURE 1 of *Oelsch*. Portions 7 and 8 remain rigid, and force the center of the membrane to flex further upwardly.

this additional reason, the rejection is improper. Reconsideration and favorable action are requested.

Claim 1 recites "a membrane which has . . . spaced first and second sections . . . that each serve as resilient structure capable of yieldably varying in size in a direction lengthwise of said membrane." The Office Action asserts Claim 1 is anticipated by *Oelsch* and argues that "the membrane that forms the sections is 'a flexible, elastic switching film' (col.1, line 11)" and "the sections of *Oelsch* 'serve as resilient structure capable of yieldably varying in size' as claimed." But claim 1 is not anticipated because no portion of *Oelsch* has been identified that discloses that sections 7 and 8 are capable of yieldably varying in size in a direction lengthwise of said membrane." Rather, Sections 7 and 8 are "salient, nonreversible bends of the switching film 3" (Column 2, lines 58-59); thus, the fact that membrane 3 of *Oelsch* is flexible does not mean that sections 7 and 8 are resilient structures capable of yieldably varying in size. Further, no portion of *Oelsch* has been identified that discloses that sections 7 and 8 are capable of yieldably varying in size in a direction lengthwise of said membrane." As described in Applicants' previous response, *Oelsch* emphasizes at lines 39-43 of column 3 that the portions 7 and 8 experience no significant change in shape as the membrane 3 moves between actuated and deactuated positions, and lines 3-7 in column 3 emphasize that the portions 7 and 8 do not experience any significant changes in shape when the length of the membrane increases due to absorption of moisture. Thus, it has not been demonstrated that *Oelsch* teaches that sections 7 and 8 are capable of yieldably varying in size in a direction lengthwise of said membrane. For at least this reason, Claim 1 is allowable. Reconsideration and favorable action are requested.

Claim 7 additionally recites "wherein said first and second portions of each said membrane section tilt with respect to said third portion thereof in response to exertion on said membrane of one of a lengthwise contraction force and a lengthwise expansion force." For reasons analogous to those described above with respect to Claim 19, *Oelsch* does not teach this limitation nor does the Office Action assert it does. For at least this reason, Claim 7 is allowable. Reconsideration and favorable action are requested.

As depending from either allowable independent Claims 1 or 15, all objected to or rejected dependent claims are also allowable. Reconsideration and favorable action are requested.

**Allowable Subject Matter**

The Office Action indicates that Claims 14, 21, 37 and 38 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Applicants appreciate this indication of allowable subject matter, but do not rewrite these claims because, as described above, the independent claims from which they depend are allowable. Favorable action is requested.

Applicants appreciate the indication that Claims 10, 20 and 25-36 are allowable.

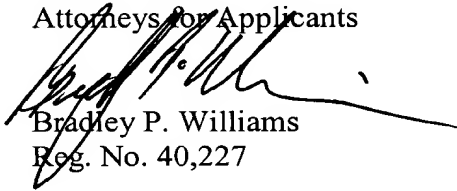
**CONCLUSION**

Applicants have now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other apparent reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, please feel free to contact the undersigned attorney for Applicants.

Applicants believe that no fee is due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,  
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Date: December 29, 2003

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